

## REMARKS

### I. Amendments to the Specification

The Title has been amended to better point out and describe the invention.

The priority claim has been amended to show the relationship between the claimed applications, and now complies with 37 CFR 1.78(a)(2)(i).

### II. Claim Rejections

A. Please cancel without prejudice or disclaimer, Claim 20 and Claims 28-30.

B. The Rejections Under 35 U.S.C. §112, First Paragraph.

The Examiner has rejected Claims 19-23 and 27-30 as allegedly failing to comply with the enablement requirement. Applicants respectfully traverse the rejection. The Applicants state on page 2, beginning at line 4, "Osteoarthritis is generally due to an imbalance in the synthesis and destruction of articular cartilage, and is prevalent in approximately 70% of women and 60% of men over 65 years of age (Chikanza et al., Expert Opin. Investig Drugs (2000) Jul; 9(7): 1499-510)." Example 2 of the specification shows PRO4425 expression in early bone at developmental stage E11-E12 and then its expression switches to cartilage from E13 onward, suggesting that PRO4425 is involved in regulating cartilage growth and maintenance. This is shown in Figure 6 in the developing rib, in Figure 10 in the cartilaginous structure of the trachea, and especially in Figure 8, with expression in the developing digits. In order to further support a disclosed utility within the instant application, Applicants attach Exhibit A herewith, which is microarray data showing overexpression of PRO4425 in osteoarthritis when compared to normal patients. In this experiment, cartilage samples were removed from patients with osteoarthritis and compared with samples from healthy individuals. RNA was prepared from each sample and hybridized to microarrays. This result indicates that PRO4425 is overexpressed 1.7 fold and 3.4 fold in respective experiments, further supporting the utility that PRO4425 is involved in the development of cartilage in development, and overexpressed in a disease state in the adult. In view of the above, Applicants respectfully submit the requirements of 35 U.S.C. §112 first paragraph are satisfied.

The Examiner has also rejected Claims 19-23 and 27-30 as allegedly failing to comply with the U.S.C. §112 written description requirement. Applicants have amended the claims to better reflect the subject matter as described in the specification to convey to one skilled in the art that the inventors possessed the claimed invention at the time of filing.

Attached hereto are separate pages containing all the pending claims and their status. Withdrawn or canceled claims do not have the claim text. The above-described amendments add no new matter, thus their entry is respectfully requested.

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In light of the above amendments and remarks, Applicant now believe that this application is condition for immediate allowance and respectfully request that the outstanding rejections be withdrawn and this case passed to issue. The examiner is invited to contact the undersigned at (650) 225-3733 if any issues may be resolved in that manner

Respectfully submitted,  
GENENTECH, INC.

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By: 

David A. Carpenter, Ph.D.

Reg. No. 45,945

1 DNA Way, MS 49  
South San Francisco, CA 94080  
Phone: (650) 225-3733  
Fax: (650) 952-9881  
carpenda@gene.com



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